

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

PERFORMANCE CHEMICAL COMPANY

Plaintiff

v.

TRUE CHEMICAL SOLUTIONS, LLC

Defendant

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Civil Action No. 6:21-CV-0222-ADA

**ORDER ON PCC'S MEMORANDUM IN SUPPORT OF PRETRIAL FILINGS
OBJECTING TO THE ADMISSION OF EVIDENCE ON ISSUES NOT IN THE CASE**

BEFORE THE COURT is Performance Chemical Company's Memorandum in Support of Pretrial Filings Objecting to the Admission of Evidence on Issues Not in the Case ("Memorandum") [Dkt. 289]. Also before the Court, to the extent raised by issues presented in the Memorandum, are PCC's Omnibus Objections to True Chem's Pretrial Disclosures [Dkt. 252], PCC's Motions in Limine and True Chem's responses thereto [Dkt. 245, 254], and the parties' Joint Notice Regarding Agreed Pending Motions in Limine [Dkt. 261].

Based on the Court's prior Orders denying True Chemical Solutions, LLC's Motion for Leave to Amend its Answer, Affirmative Defenses and Counterclaims dated June 24, 2020 [Dkt. 134] and denying True Chemical Solutions, LLC's Motion for Leave to Amend its Invalidity Contentions dated November 12, 2020 [Dkt. 211], it is ORDERED that the following issues shall not be presented to the jury at trial, by way of argument, evidence, proffered expert opinions or otherwise: (1) defenses or claims of inequitable conduct and/or violation of duty of candor; and (2) defenses or claims of prior public use.

It is further ORDERED that, because True Chemical Solutions, LLC has not disclosed adequate expert opinions, the following issues shall not be presented to the jury at trial, by way of argument, evidence, proffered expert opinions or otherwise: (1) invalidity based on obviousness; (2) invalidity based on anticipation as to any prior art references separate and apart from the *Angellini* reference (U.S. Patent Application Publication No. 2011/0132815); and (3) reference to any of True Chemical Solutions, LLC's trailers as non-infringing alternatives.

The parties are directed to meet and confer and then present the Court with a joint list of prior objections to specific pretrial filings, exhibits, witnesses, deposition designations and motions in *limine* that they agree are resolved by this Order, as well as a joint list of all objections to pre-trial filings, exhibits, witnesses, deposition designations and motions in *limine* that remain in dispute, on or before Thursday, March 25, 2021.

Moreover, based on the hearing held on December 10, 2020, the Court memorializes its oral rulings made at that time, as follows:

- True Chemical Solutions, LLC's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,011,501 [Dkt. 186] is hereby DENIED in its entirety;
- True Chemical Solutions, LLC's Summary Judgment Motion for Non-Infringement of Certain True Chemical's Trailers [Dkt. 185] is hereby DENIED in its entirety;
- True Chemical Solutions, LLC's Summary Judgment that U.S. 9,834,452 and U.S. 10,011,501 Are Invalid Based on Prior Public Use [Dkt. 189] is hereby DENIED in its entirety;
- True Chemical Solutions, LLC's Motion to Exclude Performance Chemical Company's Expert Scott Weingust [Dkt. 184] is hereby DENIED in its entirety;
- Performance Chemical Company's Motion to Strike Improper Expert Opinions of Dr. Bradley Ewing [Dkt. 188] is hereby GRANTED and Dr. Ewing's opinions are STRUCK in their entirety; and

- Performance Chemical Company's Motion to Disqualify Mr. Patrick K. Steele as Expert Witness and Strike Improper Expert Testimony [Dkt. 187) is hereby GRANTED IN PART limited to opinions on inequitable conduct, DENIED IN PART as to all other challenges, including challenges to Mr. Steele's qualifications .

Finally, it is further ORDERED that True Chemical Solutions, LLC's Motion for Reconsideration Regarding Motion to Leave to Amend Invalidity Contentions [Dkt. 324] is hereby DENIED in its entirety.

SIGNED on this 25th day of March, 2021.


ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE